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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/501,793 02/10/00 PARRISH

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EXAMINER

PM82/0314

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FISCHER, A
ART UNIT

PAPER NUMBER

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DATE MAILED:

03/14/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/501,793

Applicant(s)
Rob G. Parrish

Examiner
Andrew J. Fischer

Group Art Unit
2167



☒ Responsive to communication(s) filed on Jan 22, 2001

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-58 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-58 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Election/Restriction

1. Applicants response (Paper No. 4) to the restriction (Paper No. 3) is acknowledged. Applicant states, the “method, apparatus, and system claims are so related so as to prevent patentably distinct inventions,” and that “[b]ecause the inventions are not patentably distinct, Applicant contends that a restriction requirement is improper.” Because of these statements, the Examiner hereby withdraws the restriction.
2. The Examiner reminds Applicant the Examiner may at any time restrict the application if amendments to the claims, statements by Applicant, or other reasons give rise to a restriction.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. The drawings are replete with these errors. Some examples follow. While no new matter is allowed, the following must be shown or the features cancelled from the claim(s):
 - a. “threads positioned to engage the mounting member” as recited in claim 5.

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Claim Rejections - 35 USC § 112 1st Paragraph

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 11-20 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In claim 11, it is not known how the cylinders mount to the mounting portion.

Claim Rejections - 35 USC § 112 2nd Paragraph

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 3, and 37-58, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are replete with errors. Some examples follow.

- a. In claim 3, it is unclear if “a block” is the same or different from “a block” as recited in claim 2.

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b. In claim 37, it is unclear whether the applicant is claiming the subcombination of a storage compartment or the combination of a storage compartment and both a receptacle and amounting portion.

If the applicant's intent is to claim only the subcombination, the body of the claim(s) must be amended to remove any positive recitation of the combination. If the applicant intends to claim the combination, the preamble of the claim must be amended to be consistent with the language in the body of the claim.

It is the Examiner's position that the limitations "for a vehicle having a receptacle for holding a trailer hitch mounting apparatus have a male trailer hitch" are functional limitations which are given little patentable weight thereby placing any such positive structural limitations found within this phrase to be outside the claim's scope. In addition to the above, if Applicant(s) concur with the Examiner's position, the Examiner respectfully requests Applicant(s) to explicitly state their concurrence on the record. Upon receiving such concurrence, the 35 U.S.C. §112 second paragraph rejection will then be withdrawn.

Alternatively, if Applicant(s) argue that the limitation should be given greater patentable weight requiring the Examiner to show the prior art having such structural features, the 35 U.S.C. §112 second paragraph rejection will be maintained.

c. In claim 39, it is unclear how a block may be positioned "for insertion through all of the receptacle" since its block may not go through the sides of the receptacle.

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Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-7, 9, 10, 37-43, and 45-46 are rejected under 35 U.S.C. 102(b) as being anticipated by Klemetsen (U.S. 5,476,297). Klemetsen discloses an apparatus with the following: a mounting portion (2); and a mounting portion receptacle (4); a block (inherent since it goes through 16); a friction member connected to the receptacle (inherent, the block as a bolt or pin); threads (on 18) positioned to engage the mounting member (figure 4); the mounting portion is fixed or movably attached to the receptacle (inherent since it may be welded, the weld cut, and rewelded); the mounting portion comprises a substantially flat member (the step above 4 in figure 1); and the mounting portion includes holes (figure 4).

10. Functional recitation(s) using the word “for” (e.g. “for insertion through at least a portion of the receptacle”) have been given little patentable weight because they fail to add any structural limitations and are thereby regarded as intended use language. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. *In re Casey*, 152 USPQ 235 (CCPA 1967); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

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Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 11-20 and 47-56 as understood by the Examiner, are rejected under 35

U.S.C. 103(a) as being unpatentable over Klemetsen. Klemetsen discloses as discussed above and does not directly disclose cylinders. However, the Examiner takes Official Notice that cylinders (as bolts or pins) are old and well known in the art to attach to items together. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Klemetsen to include cylinders as bolts or pins threadedly connecting the mounting portion. Such a modification would have made connection between the two easier to disconnect.

13. Claims 8 and 44, as understood by the Examiner, are rejected under 35 U.S.C. 103(a) as being unpatentable over Klemetsen in view of Francisco (U.S. 4,991,865). Klemetsen discloses as discussed above and does not directly disclose the mounting portion being pivotally attached. Francisco teaches using a mounting portion (28) pivotally attached mounting receptacle (18, figure 7) to allow the vehicle and trailer to be further apart during hitching.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Klemetsen as taught by Francisco to include the mounting

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portion being pivotally attached to the receptacle. Such a modification would allowed the vehicle and trailer to be further apart during hitching.

14. Claims 21-36 are rejected under 35 U.S.C. 103(a) as being unpatentable in view Klemetsen and Applicant's admission that "the inventions are not patentably distinct," (Paper No. 4, page 3, line 6).

15. Claims 57 and 58, as understood by the Examiner, are rejected under 35 U.S.C. 103(a) as being unpatentable over Klemetsen in view of Howell (U.S. 6,170,723). Klemetsen discloses as discussed above and does not directly disclose a storage compartment. Howell a storage compartment to store objects. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Klemetsen as taught by Howell to include the mounting portion integrally formed with a wall of the storage compartment. Such a modification would have prevented the metal apparatus from rattling around within the box.

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Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure includes the following: Ludwick (U.S. 5,738,632); Kravitz (U.S. 5,735,539); Breslin (U.S. 5,593,172); McCoy (U.S. D 376,780); Wilson (U.S. 5,464,264); Carsten (U.S. 5,322,315); Blaser (U.S. 5,277,447); Nichols (U.S. 2,637,566); and Stimac (U.S. 5,845,921).

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew J. Fischer whose telephone number is (703) 305-0292.



**ANDREW J. FISCHER
PATENT EXAMINER**

 3/8/01

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AJF
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